

REMARKS

Applicants have amended claims 7 and 9 to correct a typographical error and to claim aspects of their invention with respect to hybridization under high stringency.

Claims 7, 9 and 10 stand rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner states that “[a]lthough SEQ ID NO: 14 (part of SEQ ID NO:2) and SEQ ID NO:13 are disclosed in the specification, amino acid sequence[s] having at least 90% similarity to all or part of SEQ ID NO:14 are not disclosed.” Further, the Examiner states that “protein encoded by nucleotide sequence having at least 90% similarity to all or part of SEQ ID NO:13 and/or is capable of hybridizing to SEQ ID NO:13 under high stringency conditions are also not disclosed in the specification.”

Applicants have amended claim 7 so that it no longer recites sequences “having at least a 90% similarity to all or part of SEQ ID NO.14.” Applicants have similarly amended claim 9 so that it no longer recites nucleotide sequences “having at least 90% similarity to all or part of SEQ ID NO:13.” Applicants acknowledge that sequences that are similar to any part of a sequence can include almost any sequence. Accordingly, claims 7 and 9 have been amended to include SEQ ID NO: 14, SEQ: ID NO: 13 and sequences capable of hybridizing to these sequences under high stringency conditions as defined at page 14, lines 14-17, of the specification.

As the Examiner will note, applicants have described embodiments of their invention on page 13 of the specification as including the claimed proteins plus proteins encoded by nucleotide sequences that will hybridize under low stringency conditions to the identified sequences encoding the claimed proteins. What applicants have done here is to claim a subset of their invention as broadly described, since the sequences which will hybridize under low stringency conditions by necessity include those sequences that will hybridize under medium and high stringency conditions (as defined on page 14 of the specification) as well. In other words, persons skilled in this art would recognize that applicants’ invention as described on page 13 of the specification necessarily

includes sequences that will hybridize under medium and high stringency as well as those that will hybridize under low stringency conditions. There is nothing that compels applicants to claim all of their invention as disclosed, as long as persons skilled in the art can recognize that they invented what they do claim. That is the case here.

In addition to describing the claimed proteins by their structural characteristics, applicants also describe the claimed proteins functionally. Specifically, claim 7 states that the isolated protein is “produced in a larger amount in hypothalamus tissue of obese animals as compared to lean animals.” The Examiner states that such a characteristic is not a functional characteristic. Applicants respectfully submit that the Examiner’s position is unsupported by the disclosure of this application and is, as a general proposition, untenable. The fact that the isolated protein appears in larger amounts in obese animals compared to lean animals is a testable feature of the protein that can be used to distinguish the claimed proteins from proteins that are not within the scope of applicants’ invention.

The combination of the described structural and functional characteristics of the claimed proteins constitutes an adequate written description of the claimed invention. Accordingly, this rejection should be withdrawn.

Claims 7, 9 and 10 stand rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the enablement requirement. As described above, the claims have been amended to no longer include sequences “having at least a 90% similarity to all or part of SEQ ID NO:14” and to no longer include nucleotide sequences “having at least 90% similarity to all or part of SEQ ID NO:13.”

The specification, as previously explained, enables one of skill in the art to identify isolated proteins that include a sequence that hybridizes to SEQ ID NO:14 or SEQ ID NO:13 under high stringency conditions. Further, the specification would enable one of skill in the art to determine whether such protein is produced in a larger amount in hypothalamus tissue of obese animals as

compared to lean animals. Accordingly, one skilled in the art would be able to make and use the claimed isolated proteins.

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **229752000701**.

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Respectfully submitted,

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